

Serial No. 10/604,418
Filed: July 18, 2003
Page 2 of 9

Examiner: Yaritza Guadalupe McCall
Group Art Unit: 2859

REMARKS/ARGUMENTS

Claims 1-56 and 59-72 are pending in the application. In this Office action, claims 22-32 and 60-62 stand rejected under 35 U.S.C. §103(a), notwithstanding these claims were previously allowed. Claims 63-68 stand objected to, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 1-21, 33-56, 59, and 69-72 stand allowed. Applicant appreciates the Examiner's notification of allowable subject matter.

Reconsideration and reexamination of the application is respectfully requested in view of the following remarks.

Rejection Under 35 U.S.C. §103(a)

Claims 22-32 and 60-62 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over US Patent No. 5,790,256 to Brown et al. in view of US Patent No. 5,025,476 to Gould et al. The rejection is respectfully traversed.

Legal Standards Concerning Rejections Under 35 U.S.C. §103(a)

A claimed invention is unpatentable if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art....The ultimate determination of whether an invention would have been obvious under 35 U.S.C. §103(a) is a legal conclusion based on underlying findings of fact.¹

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field....Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall

¹The underlying factual inquiries include (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; and (3) the differences between the claimed invention and the prior art. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 15 L. Ed. 2d 545, 86 S. Ct. 684 (1966).

Serial No. 10/604,418
Filed: July 18, 2003
Page 3 of 9

Examiner: Yaritza Guadalupe McCall
Group Art Unit: 2859

victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher."

Most if not all inventions arise from a combination of old elements....Thus, every element of a claimed invention may often be found in the prior art....However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention....Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant....Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference.

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved....In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references....The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art....Whether the Patent Office Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto....Broad conclusory statements standing alone are not "evidence."

In Re Werner Kotzab, 217 F.3d 1365; 55 U.S.P.Q.2d (BNA) 1313 (Fed. Cir. 2000)(citations omitted)(emphasis added).

The Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the relevant art would lead that individual to combine the relevant teachings of the references. The Examiner cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1780, 1783 (Fed. Cir. 1988). When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. *In re Rouffet*,

Serial No. 10/604,418
Filed: July 18, 2003
Page 4 of 9

Examiner: Yaritza Guadalupe McCall
Group Art Unit: 2859

149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight. *In re Dembiczaik*, 175 F.3d at 999, 50 USPQ2d at 1617. See, also, *Manual of Patent Examining Procedure* §706.02(j).

Section 706.02(j) of the Manual of Patent Examining Procedure is explicit as to what must be done to support a rejection under 35 U.S.C. §103(a).

"After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,
- (B) the difference or differences in the claim over the applied reference(s),
- (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and
- (D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. 'To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.' *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)."

The Examiner has failed to identify any motivation, suggestion, or teaching of the desirability of combining Brown '256 and Gould '476 to arrive at Applicant's invention. No statement in either Brown '256 or Gould '476 has been identified relating to the desirability of

Serial No. 10/604,418
Filed: July 18, 2003
Page 5 of 9

Examiner: Yaritza Guadalupe McCall
Group Art Unit: 2859

combining Brown '256 and Gould '476, there has been no discussion of the knowledge of one of ordinary skill in the art or the nature of the problem to be solved, there has been no identification of what the combined teachings, the knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to one of ordinary skill in the art, as required for a showing of motivation. The Examiner has failed to provide any particular findings related to any motivation, suggestion, or teaching of the desirability of combining Brown '256 and Gould '476. Rather, the Examiner has simply relied upon "broad conclusory statements standing alone" to support the combining of Brown '256 and Gould '476, and has merely attempted to identify in Brown '256 and Gould '476 the individual parts claimed by Applicant. Indeed, because the Examiner has failed to support the combination of Brown '256 and Gould '476 with particular factual findings supporting the asserted combination, the only conclusion that can be drawn is that the Examiner has engaged in impermissible hindsight reconstruction using Applicant's disclosure as a blueprint. This is contrary to the established legal standards for a finding of obviousness, and cannot be sustained. The rejection of claims 22-32 and 60-62 is improper and should be withdrawn.

Even if the asserted combination were proper, the combination of Brown '256 and Gould '476 would fail to describe the claimed invention.

Claims 22-32

Claim 22 calls for a method of making a shoe correction for the alignment of a person's foot. The method comprises the steps of measuring the lateral angular alignment of the person's foot with respect to the lower portion of the leg, and selecting from a database appropriate corrective components for incorporation into a shoe to correct the alignment of the person's foot.

Serial No. 10/604,418
Filed: July 18, 2003
Page 6 of 9

Examiner: Yaritza Guadalupe McCall
Group Art Unit: 2859

Brown '256 discloses a foot analyzer comprising a pair of four-sided foot wells having 1) a pair of pressure pads comprising pressure sensitive, variable resistors on which a person stands, 2) linear arrays of infrared transmitters along the lower edges of the foot well walls, and 3) arrays of infrared transmitters in the side walls of the foot wells. A person stands on the pressure pads with one foot in each well. The pressure pads and infrared transmitters are activated and the data from these devices is recorded and processed in a computer controller. The infrared transmitters along the lower edges of the foot well walls are used to determine width and length of the person's feet. *See, e.g. col. 6, ln. 23-46.* The infrared transmitters in the side walls are used to determine the height of the person's feet. *See, e.g. col. 6, ln. 49-58.* The pressure pads are used to develop a pressure profile for each foot, which is displayed on a monitor screen.

Specific data developed from the pressure pads and infrared transmitters can include distributed weight values throughout each foot, overall weight, foot length, foot width, foot heights at various locations along the foot, and foot volume. Bunions and toe deformities that would interfere with shoe comfort can also be detected. Specific data can then be compared with stored information related to shoe size and available shoe volume, and properties of various orthotic materials such as cushioning, force absorption, deflection, compression, rigidity, and the like. *See, col. 18, ln. 30-44. See, also, col. 13, ln. 1-2.*

Nowhere does Brown '256 disclose measuring the lateral angular alignment of a person's foot. Indeed, measuring the lateral angular alignment of a person's foot must involve measurements taken from either the front or rear of the foot, which must involve determining the lateral inclination of the person's lower leg. The only instrumentation in the front or rear of the Brown '256 foot wells is a linear array of infrared transmitters along the lower edges of the front and rear walls. This linear array of transmitters is incapable of determining the lateral inclination of the person's lower leg. Thus, the Brown '256 apparatus is incapable of measuring the lateral angular alignment of a person's foot.

Serial No. 10/604,418
Filed: July 18, 2003
Page 7 of 9

Examiner: Yaritza Guadalupe McCall
Group Art Unit: 2859

Gould '476 discloses an apparatus for determining the "topography" of the soles of a person's foot through a process known as moiré fringe analysis. The analysis enables particular reference points, called a "signature" for the foot, to be established for the person's foot, which can be compared to a database of signatures to select a single signature corresponding to the person's foot. This database signature can then be used to select a shoe size and width. The signature can also be used to select the length of a corrective insert for a shoe and its width at the heel and in the area beneath the ball of the foot, or to enhance the accuracy of diagnosis of foot problems. Nowhere does Gould '476 disclose measuring the lateral angular alignment of a person's foot.

Because neither Brown '256 nor Gould '476 discloses an apparatus or a methodology for measuring the lateral angular alignment of a person's foot, the combination of Brown '256 and Gould '476 fails to describe the method of Applicant's claim 22, which requires measuring the lateral angular alignment of the person's foot with respect to the lower portion of the leg.

The Examiner asserts that measuring the lateral angular alignment of the person's foot with respect to the lower portion of the leg is disclosed in lines 17-21 of the Abstract, column 3, lines 35-40, and column 4, lines 43-46 of Brown '256. However, lines 17-21 of the Abstract read "According to one method, the pressure sensors and optical sensors are utilized to determine, among others, foot length, foot width, shoe size, foot volume, foot shape, force distribution, pronation, arch type, and recommended last type." Lines 35-40 of column 3 read "Precise objective criteria, such as overall weight, pressure distribution, foot length, foot width, foot height, and foot volume are measured and compared with stored information related to shoe size and volume, cushioning and force absorption properties of various orthotic materials." Lines 43-46 of column 4 read "Still another object of the present invention is to provide an apparatus and a method for analyzing feet which selects an orthotic or insole material based upon measured and calculated data and planned activity." None of these statements even remotely describes measuring the lateral angular alignment of the person's foot with respect to the lower portion of the leg. Thus, none of these statements supports the Examiner's assertion.

Serial No. 10/604,418
Filed: July 18, 2003
Page 8 of 9

Examiner: Yaritza Guadalupe McCall
Group Art Unit: 2859

Gould '476 is relied upon for its alleged disclosure of selecting from a database appropriate corrective components for incorporation into a shoe to correct the alignment of the person's foot, since the Examiner asserts that this is not disclosed in Brown '256. However, Brown '256 does disclose comparing measured values for a person's feet with stored information relating to shoe size, shoe volume, and properties such as cushioning, force absorption, deflection, compression, rigidity, etc. *See, col. 18, ln. 30-44.* Thus, there would be no motivation to combine Gould '476 with Brown '256 in the manner asserted by the Examiner. Nevertheless, as discussed above, even if Gould '476 and Brown '256 were properly combined for the reasons asserted by the Examiner, the resulting combination would still not describe the method of claim 22.

For these reasons, claim 22 is patentable over the asserted combination of Brown '256 and Gould '476. Applicant requests the withdrawal of the rejection of claim 22, and the allowance of claim 22.

Since claims 23-32 depend directly or indirectly from claim 22, claims 23-32 are similarly not rendered unpatentable by the asserted combination of Brown '256 and Gould '476. Applicant requests the withdrawal of the rejection of claims 23-32, and the allowance of claims 23-32.

Claims 60-62

Claim 60 describes a database comprising a plurality of preselected lateral angular alignment values and at least one corrective alignment insole component, wherein the preselected lateral angular alignment values are correlated to the at least one corrective alignment insole component so that the at least one corrective alignment insole component can be selected from the database based upon a lateral angular alignment measurement.

Neither Brown '256 nor Gould '476 discloses a database comprising a plurality of preselected lateral angular alignment values. As described above, nothing in Brown '256 or Gould '476 relates in any way to measuring the lateral angular alignment of a person's foot. Thus, no database in Brown '256 or Gould '476 contains any preselected lateral angular

Serial No. 10/604,418
Filed: July 18, 2003
Page 9 of 9

Examiner: Yaritza Guadalupe McCall
Group Art Unit: 2859

alignment values, and no combination of Brown '256 or Gould '476 could result in a database comprising a plurality of preselected lateral angular alignment values.

The Examiner asserts that Brown '256 and Gould '476 disclose a database comprising a plurality of preselected lateral angular alignment values. However, the Examiner fails to identify anything in Brown '256 or Gould '476 in support of this assertion. Indeed, such an assertion cannot be sustained as discussed above, and is patently inaccurate.

For these reasons, claim 60 is patentable over the asserted combination of Brown '256 and Gould '476. Applicant requests the withdrawal of the rejection of claim 60, and the allowance of claim 60.

Since claims 61 and 62 depend directly or indirectly from claim 60, claims 61 and 62 are similarly not rendered unpatentable by the asserted combination of Brown '256 and Gould '476. Applicant requests the withdrawal of the rejection of claims 61 and 62, and the allowance of claims 61 and 62.

CONCLUSION

For the reasons discussed above, all of the claims are in condition for allowance. Early notification of allowability is requested.

If there are any remaining issues which the Examiner believes may be resolved in an interview, the Examiner is invited to contact the undersigned.

Respectfully submitted,

ADRIANO ROSA

By:

Michael F. Kelly, Reg. No 50,859
John E. McGarry Reg. No. 22,360
McGARRY BAIR PC
171 Monroe Avenue, NW, Suite 600
Grand Rapids, Michigan 49503
616-742-3500

G0186638

Dated: 09/09/05